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TO: Commissioner for Patents	COMPANY: U.S. Patent & Trademark Office	FAX #: 703-872-9306
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DATE: FROM: OPERATOR: CLIENT/MATTER: PAGES:	January 18, 2005 Morgan S. Heller II Karen Jeffer 07689-00021 57 (including cover)	Reviewed and approved for facsimile transmission by:

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Comments

BTV.235986.1

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JAN 18 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John E. Cronin

Serial No.: 09/781,361

Filed: February 12, 2001

Title: Invention Interview Process

Attorney Docket No.: ipCG-509
(07689-00021)☒ CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office. Fax No. 703-872-9306, on the date shown below.

 01/18/05
Morgan S. Heller II Date

Group Art Unit: 2121

Examiner: Michael B. Holmes

Commissioner for Patents
Alexandria, VA 22313-1450

January 18, 2005

TRANSMITTAL

In connection with the above-identified application, please find attached a Request to Withdraw Notice of Abandonment Under 37 C.F.R. § 181(a).

- ☒ The Commissioner is hereby authorized to charge payment of the fees associated with this communication or credit any overpayment to Deposit Account No. 04-1588. A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. § 1.16.
- ☒ Any patent application processing fees under 37 C.F.R. § 1.17.

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC

By: Morgan S. Heller II
Attorney of Record
Registration No.: 44,756
Tel: (802) 863-2375

BTV.425496.1

P241-2/01

Law Offices of
Downs Rachlin Martin PLLC
199 Main Street, P.O. Box 190
Burlington, VT 05402-0190

RECEIVED
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JAN 18 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John E. Cronin

Serial No.: 09/781,361

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Title: Invention Interview Process

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☒ CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 703-872-9306, on the date shown below.


Morgan S. Heller II01/18/05
DateCommissioner for Patents
Alexandria, VA 22313-1450

January 18, 2005

**REQUEST TO WITHDRAW NOTICE OF ABANDONMENT
UNDER 37 C.F.R. § 181(a)**

This is in response to the Notice of Abandonment (paper no. 8) mailed from the U.S. Patent and Trademark Office on December 10, 2004, with respect to the above-identified patent application. A true copy of the Notice of Abandonment is attached as Exhibit A.

On December 4, 2003, the U.S. Patent and Trademark Office issued a first Office Action regarding the above-identified patent application. A true copy of the December 4, 2003 Office Action is attached hereto as Exhibit B.

On March 4, 2004, the undersigned attorney, acting at the behest of the assignee of the present application, submitted via facsimile a Response to the December 4, 2003 Office Action. True copies of the March 4, 2004 Response and the corresponding official Auto-Reply Facsimile Transmission verification page are attached hereto as Exhibit C.

Law Offices of
Downs Rachlin Martin PLLC
199 Main Street
P.O. Box 190
Burlington, VT 05402-0190
(802) 863-2375

On September 20, 2004, Examiner Michael B. Holmes telephoned one of the attorneys of record, Ryan Simmons, and informed Attorney Simmons that the Examiner had not yet received a response to the December 4, 2003 Office Action. During this call, the Examiner requested that Attorney Simmons provide the Examiner with the Response mailing and a facsimile verification of the mailing of the Response.

On September 22, 2004, Attorney Simmons faxed a copy of the March 4, 2004 Response to the attention of Examiner Holmes using fax number 703-746-5423. A true copy of Attorney Simmons' facsimile of September 22, 2004, is attached as Exhibit D. (Unfortunately, Attorney Simmons is unable to retrieve verification that the September 22, 2004 facsimile in fact transmitted properly. Apparently, the request for verification was made beyond the verification retrieval window for the fax machine used.)

On December 10, 2004, the U.S. Patent and Trademark Office mailed the present Notice of Abandonment to Attorney Simmons. Apparently, Examiner Holmes never received Attorney Simmons' September 22, 2004 facsimile that contained a copy of the March 4, 2004 Response.

Attorney Simmons, on behalf of the present assignee, has requested the undersigned attorney to resolve the present abandonment issue.

The undersigned attorney believes that Exhibit C hereto, which includes not only a true copy of the March 4, 2004 Response, but also the U.S. Patent and Trademark Office's auto-reply verification page, incontrovertibly shows that a response to the December 4, 2003 Office Action was indeed submitted on March 4, 2004, within the three month shortened statutory period set in the December 4, 2003 Office Action.

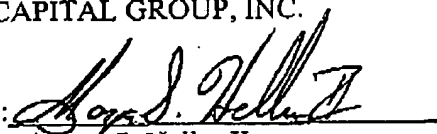
Since the March 4, 2004 Response was timely submitted to the U.S. Patent and Trademark Office, it is respectfully submitted that the present application has improperly been deemed abandoned. Therefore, it is respectfully requested that the Notice of Abandonment be withdrawn.

If any issues remain, it is encouraged that the undersigned attorney be contacted at the number listed below.

Respectfully submitted,

IPCAPITAL GROUP, INC.

By:



Morgan S. Heller II

Registration No.: 44,756

Downs Rachlin Martin PLLC

Tel: (802) 863-2375

BTV.425196.1

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1-150
Alexandria, Virginia 22312-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781.361	02/12/2001	John E. Cronin	ipCG-509	2468

7590

12/10/2004

Ryan Simmous
ip Capital Group, Inc.
Suite 325
400 Cornerstone Drive
Williston, VT 05495

EXAMINER

HOLMES, MICHAEL B

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 12/10/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment

Application No.

09/781,361

Applicant(s)

CRONIN, JOHN E.

Examiner

Michael B. Holmes

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 04 December 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


 Anthony Knight
 Supervisory Patent Examiner
 Group 3200

571-272-3687

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Interview Summary	Application No.	Applicant(s)	
	09/781,361	CRONIN, JOHN E.	
	Examiner	Art Unit	
	Michael B. Holmes	2121	

All participants (applicant, applicant's representative, PTO personnel):

(1) Michael B. Holmes.

(3) _____

(2) Ryan Simmons, Reg. No. 45,848.

(4) _____

Date of Interview: 20 September 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____

Claim(s) discussed: N/A.

Identification of prior art discussed: N/A.

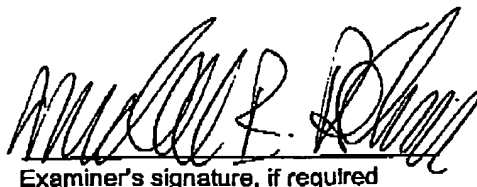
Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Called, spoke with attorney requested facsimile verification of mailing, and requested mailing of response. However, as of date, no response has been received.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,361	02/12/2001	John E. Cronin	ipCG-509	2468
7590 12/04/2003			EXAMINER	
Ryan Siminous ip Capital Group, Inc Suite 325 400 Cornerstone Drive Williston, VT 05495			HOLMES, MICHAEL B	
			ART UNIT	PAPER NUMBER
			1121	7
DATE MAILED: 12/04/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,361

Applicant(s)

CRONIN, JOHN E.

Examiner

Michael B. Holmes

Art Unit

2121

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1, 7, & 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Notice of References Cited	Application/Control No. 09/781,361	Applicant(s)/Patent Under Reexamination CRONIN, JOHN E.	
	Examiner Michael B. Holmes	Art Unit 2121	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,172,175	01-2001	Ahmad et al.	715/500.1
*	B	US-6,149,441	11-2000	Pellegrino et al.	434/441
*	C	US-6,098,061	08-2000	Gotoh et al.	706/50
*	D	US-6,029,158	02-2000	Bertrand et al.	706/45
*	E	US-6,029,156	02-2000	Lannert et al.	706/11
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
*	U	PATENT IT YOURSELF (Sixth Edition), David Pressman (Nolo Press Berkeley), 1997
	V	From Patent to Profit (Secret & Strategies For The Successful Inventor, Bob DeMatteis (1998) Note: www.google.com, listing
*	W	www.patentcafe.com
*	X	www.askinventor.com

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Application/Control Number: 09/781,361
Art Unit: 2121

Page 2



UNITED STATES PATENT AND TRADEMARK OFFICE

P.O. Box 1450, Alexandria, Virginia 22313-1450 - www.USPTO.GOV

Examiner's Detailed Office Action

1. This action is responsive to application 09/781,361, filed February 12, 2001.
2. Claims 1-12 have been examined.

Information Disclosure Statement

3. Examiner acknowledges applicants' submission of prior art and information disclosure. Nevertheless, applicant is respectfully remind of the ongoing Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by continuing to submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's of application or thereafter.

Drawings

4. The formal drawings have been reviewed by the United States Patent & Trademark Office of Draftperson's Patent Drawings Review. Form PTO-948 has been provided.

Application/Control Number: 09/781,361
Art Unit: 2121

Page 3

Specification

5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the specification. Moreover, applicant will need to provide the application number for (ipCG-506, ipCG-507, ipCG-508, ipCG-509, & ipCG-519).

Claim Objections

6. Claims 1, 7, & 12 are objected to because of the following informalities: Claim 1 refers to an "iterative processing" of step (c) i.e., (c) iterating (b)(i) to (b)(ii), of which are not present. Examiner will not speculate as to applicant's intentions. Examiner interprets this as a typo, claim 11, has the missing iteration. Appropriate correction is required. Claim 7 has an improper dependency i.e., claim 7 is dependent upon it self. Examiner interprets applicant intention was to have claim 7, dependent upon claim 6. Appropriate correction is required. Finally, Claim 12 is dependent upon a claim that does not exist i.e., claim 13. Examiner interprets "Alternate Questioning Themes" referring to claim 11, as applicant's intentions. Appropriate correction is required.

Claim Interpretation

7. Office personnel are to give claims their "broadest reasonable interpretation" in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA

Application/Control Number: 09/781,361

Art Unit: 2121

1969). See *also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). see MPEP § 2106

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. The invention as disclosed in claims 1-12 is directed to nonstatutory subject matter i.e., an *abstract idea* i.e., they are not limited to a *practical application* in the technological arts. The claims appear to be a method performed on a computer, however, no computer-readable medium has been disclosed by applicant. As a result, examiner will not speculate as to the intended meaning, because applicant discloses no "certain substances" that have been "transformed or reduced" that is, applicant claims disclose no *specific* computer-readable medium.

10. Furthermore, there is no manipulation of *specific* data representing physical objects or activities constituting what one may classify as pre-computer activity, nor does applicant disclose any *specific* independent physical acts being performed by the invention constituting

Application/Control Number: 09/781,361
Art Unit: 2121

Page 5

post-computer activity. Finally, the claims merely manipulate abstract ideas in general without limitation to a practical application where "certain substances" are transformed or reduced on a computer-readable medium.

11. Therefore, claims 1-12 are rejected under 35 USC § 101.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph. Specifically, if the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); *In re Kirk*, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) MPEP 2107.01 (IV)

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pressman, David, 1937 - PATENT IT YOURSELF (6th ed., 1997), (Nolo Press Berkeley)

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in view of

From Patent to Profit, Secret & Strategies For The Successful Inventor, Bob DeMatteis (1998),

Publisher: Avery.

Regarding Claim 1:

Pressman teaches,

A method of facilitating conception of inventive concepts by an inventor, the method comprising any one or more of the following:

(a) interviewing an inventor to identify or otherwise characterize a basic invention [(**You Don't Have to Use a Patent Attorney**, page 1 / 1, "*In this view, it's almost a universal misconception that one must use a patent attorney to get a valid patent ...*");

Pressman does not teach,

(b) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (a), however, *DeMatteis* teaches (b) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (a), [(**Table of Content**, **2. Your Inventive Strategy**, page 6 of 14, *How to get Prototypes Made at Little or No Cost to You*" & **3. Developing Your Invention**, page 7 of 14, "*How to Make Your Inventions "People Friendly"*)] It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matters pertains, to employ the questioning methodology i.e., specifically how-type questions, because when you are seeking specific information, about a process as complex, lucrative, time consuming, and expensive (i.e., for

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some inventors) as the inventive process from start to completion.. One of the most efficient, and comprehensive ways of obtaining the desired information is to use who, what, why, where, when, and how-type questions until they are exhausted as a means to an end, for the purpose of knowing your audience. Discover as much as possible about your audience before you prepare what you are going to say, continue to learn who they are even as you step to and through the problem. When you learn as much as you can about your audience, you'll become more comfortable with them and knowledgeable about them. Rapport will be established, and (c) iterating (b)(i) to (b)(ii) [(see claim objection)].

Regarding Claim 2:

Pressman teaches,

The method of claim 1 wherein the basic invention is identified and/or characterized by accomplishing any one or more of the following steps:

- (a) facilitating drawing of a diagram of the basic invention [G. Software and Other Computer-Related Inventions, page 8 / 7 - 8 / 9, FIG 8B-Software Flowcharts (see page 8 / 8, right column, second paragraph, "Fig 8B shows adequately detailed flowcharts ... and explains exactly how to implement the flowchart.");];
- (b) facilitating definition of one or more elements of the basic invention [G. Software and Other Computer-Related Inventions, page 8 / 7 - 8 / 9 (see page 8 / 9, Specific, item (I) "Adjust value ...");]; and
- (c) facilitating definition of problem(s) solved and/or problems to be solved by the basic invention. [G. Software and Other Computer-Related Inventions, page 8 / 7 - 8 / 9 (see page 8 / 9,

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Specific, item (f) "Solve ..."]

Regarding Claim 3:

Pressman teaches,

The method of claim 1 further comprising communicating to the inventors any one or more concepts selected from the group consisting of:

- (a) concept of an invention being a function of the problem to be solved by the basic invention, the element(s) that comprise the basic invention, and how the elements are connected or interrelated [G. Software and Other Computer-Related Inventions, page 8 / 7 – 8 / 8 (left column, fifth paragraph "You should explain in the specification how to implement the listing ... (for instance, a MDI interface" and "a laser printer" ")];
- (b) a ladder of abstraction [1. Machine Sketches, page 8 / 10 ("If your machine is complicated, you should show an exploded view of it, as in Fig. 8D.")];
- (c) prior art (C. The Novelty and Unobviousness Requirement, page 1 / 4 "prior art ..."), novelty (C. The Novelty and Unobviousness Requirement, page 1 / 4 "...novelty requirement ..."), nonobviousness (C. The Novelty and Unobviousness Requirement, page 1 / 4 "...unobvious ..."), inventive step (B. Inventing by Problem Recognition and Solution, page 2 / 2, "Now that you know what an invention ... 1) recognizing a problem, and 2) fashioning a solution.") and bar dates (Experiment exception vi. Prior Sale or On-Sale Status in the U.S., page 5 / 12-5 / 13 "35 U.S.C. 102 statutory bar");
- (d) inventorship (A. What I mean by "Invention" page 2 / 2 "For the purpose of this book ... useful."); and

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(e) enablement and written description. [G. Software and Other Computer-Related Inventions, page 8 / 7 - 8 / 8 (see page 8 / 8, left column, second paragraph, "*The special consideration applicable to software inventions is in meeting the full disclosure requirement. ... That is, make absolutely sure it contains a "full, clear, concise, and exact" description of the invention and how to make and use it.*")]

Regarding Claim 4:

Pressman teaches,

The method of claim 1 further comprising documenting and/or recording output of any of steps (a)-(c) [Chapter 3, Documentation Can Be Vital, page 3 / 1 (see B. Documents Are Vital to the Inventive Process 3/2 & C. Documentation is Vital to Prove Invention 3/3)].

Regarding Claim 5:

Pressman teaches,

The method of claim 1 further comprising documenting and/or recording administrative information. [Documentation Can Be Vital, Chapter 3, (D. Documents Are Vital to the Invention Process, page 3 / 2 "*It takes more than a good idea to sustain the invention process. It is absolutely essential to keep good, sound, records, for the following reasons: ... "*)]

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Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by

Pressman, David, 1937 - PATENT IT YOURSELF (6th ed., 1997), (Nolo Press Berkeley).

Regarding Claim 6:

Pressman teaches,

A method of "growing" a basic invention, the method comprising:

- (a) identifying the basic invention [(The Science and Magic of Inventing, page 2 / 2 "*Inventing provides things that enhance ... it could turn out to be something great!*")];
- (b) selecting a questioning theme [(B. Inventing by Problem Recognition and Solution, right column, second paragraph, page 2 / 4 "*So, if you either don't have an invention or want to make some new one, ... What problems do you encounter and how do you solve them?*")];
- (c) identifying an aspect of the basic invention by one or more inventors that falls within the questioning theme [(B. Inventing by Problem Recognition and Solution, right column, fourth paragraph, page 2 / 4 "*Also, remember that sometimes the "problem" may be the ordinary way something has been done for years, ...thereby creating the massaging effect.*")];
- (d) identifying enhancements to the basic invention by the one or more inventors, wherein the enhancements relate to the aspect of the invention [(B. Inventing by Problem Recognition and

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Solution, right column, page 2 / 3 "5. Wiz-z-er™ Gyroscopic Top ...");

(e) repeating (c) - (d) one or more times for alternate aspects of the basic invention within a questioning theme [(B. **Inventing by Problem Recognition and Solution, right column, page**

2 / 3 - 2 / 4, "6. Dolby® ...") and ("13. Grocery Shopping Cart ...")]; and

(f) repeating (b) - (e) one or more times for alternate questioning themes. [(B. **Inventing by**

Problem Recognition and Solution, right column, second paragraph, page 2 / 4 "So, if you

either don't have an invention or want to make some new one, ...Ask yourself if something can be done more easily, cheaply, simply, or reliable? "), (B. **Inventing by Problem Recognition and**

Solution, right column, page 2 / 3 "7. Xerography ... Copying documents ..."), (B. **Inventing**

by Problem Recognition and Solution, right column, page 2 / 3 "7. Xerography ...The charging of a photosensitive surface ...deposit black powder on a sheet ..."), (B. **Inventing by**

Problem Recognition and Solution, right column, page 2 / 3 "2. Intermittent Windshield

Wipers In drizzles, the slowest speed ...slow sweep was annoying"), (B. **Inventing by Problem**

Recognition and Solution, right column, page 2 / 3 "2. Intermittent Windshield Wipers

Provide a "drizzle" setting where ... but paused after each sweep")]

Regarding Claim 7:

Pressman teaches,

The method of claim 6 wherein the alternate questioning themes comprises one or more themes selected from the group consisting of:

(a) disadvantages of the basic invention [(**Inventor's Commandment #5, page 4 / 2 "Don't spend significant time or money on your creation until you have thoroughly evaluated it for**

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- commercial potential, including considering all of its advantages and disadvantages.*");
- (b) advantages of the basic invention [(Inventor's Commandment #5, page 4 / 2 "*Don't spend significant time or money on your creation until you have thoroughly evaluated it for commercial potential, including considering all of its advantages and disadvantages.*");
- (c) operability issue(s) [(E. Solving Creativity Problems, page 2 / 6 "*Unfortunately, hardly any invention ever works right ... I failed my way to success.*" ");
- (d) other ways to solve a same problem [(D. Making Ramifications of Your Invention, page 2 / 6 "*Once you've made an invention ... Why ramify?*");
- (e) licensing strategies [(G. Licensing of Inventions – An Overview, page 16 / 6 "*Usually, the owner of a patent application or patent needs to allow others to make or sell the patented invention ...*"); and
- (f) identification of competitors and/or competitive products. [(D. Making Ramifications of Your Invention, page 2 / 6 "*Once you've made an invention ... Why ramify?* item (1), (2), ...")]

Regarding Claim 8:

Pressman teaches,

The method of claim 7 further comprising prior to the "growing" of the basic invention, communicating to the inventor(s) any one or more concepts selected from the group consisting of:

- (a) concept of an invention being a function of a problem to be solved by the basic invention, element(s) that comprise the basic invention, and how the element(s) are connected or inter-related [The Science and Magic of Inventing (Inventor's Commandment #2, page 2 / 2

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"To invent successfully, be aware of problems you encounter. Also, take the time to study and investigate the practicality of new phenomena that occur by accident or flash of insight. Persevere with any development you believe has commercial potential.");

(b) a ladder of abstraction [(2. How to Enter Technical Information in the Note Book, page 3 / 6 *"Fig. 3A is an example of a properly completed notebook ... then go back and transcribe your description."*)];

(c) prior art (C. The Novelty and Unobviousness Requirement, page 1 / 4 *"prior art ..."*), novelty (C. The Novelty and Unobviousness Requirement, page 1 / 4 *"...novelty requirement ..."*), nonobviousness (C. The Novelty and Unobviousness Requirement, page 1 / 4 *"...unobvious ..."*), inventive step (B. Inventing by Problem Recognition and Solution, page 2 / 2, *"Now that you know what an invention ... 1) recognizing a problem, and 2) fashioning a solution."*), and bar dates (Experiment exception vi. Prior Sale or On-Sale Status in the U.S., page 5 / 12-5 / 13 *"35 U.S.C. 102 statutory bar"*);

(d) inventorship (A. What I mean by "Invention" page 2 / 2 *"For the purpose of this book ... useful."*); and

(e) enablement and written description. [G. Software and Other Computer-Related Inventions, page 8 / 7-8 / 8 (see page 8 / 8, left column, second paragraph, *"The special consideration applicable to software inventions is in meeting the full disclosure requirement. ... That is, make absolutely sure it contains a "full, clear, concise, and exact" description of the invention and how to make and use it."*)]

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Regarding Claim 9:

Pressman teaches,

The method of claim 7 further comprising documenting and/or recording output of any of steps (a)-(f). [Chapter 3, Documentation Can Be Vital, page 3 / 1 (see B. Documents Are Vital to the Inventive Process 3/2 & C. Documentation is Vital to Prove Invention 3/3)]

Regarding Claim 10:

Pressman teaches,

The method of claim 7 further comprising documenting and/or recording administrative information. [(B. Documents Are Vital to the Invention Process, page 3 / 2 "*It takes more than a good idea to sustain the invention process. It is absolutely essential to keep good, sound, records, for the following reasons: (1), (2), (3), (4) ...*")]

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pressman, David, 1937 - PATENT IT YOURSELF (6th ed., 1997); (Nolo Press Berkeley)

in view of

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From Patent to Profit, Secret & Strategies For The Successful Inventor, Bob DeMatteis (1998),
Publisher: Avery.

Regarding Claim 11:*Pressman teaches,*

A method of facilitating conception of inventive concepts by an inventor, the method comprising any one or more of the following:

- (a) communicating to the inventors concepts selected from the group consisting of (i) concept of an invention being a function of a problem to be solved by the basic invention, element(s) that comprise the basic invention, and how the element(s) are connected or interrelated [**The Science and Magic of Inventing (Inventor's Commandment #2, page 2 / 2 "To invent successfully, be aware of problems you encounter. Also, take the time to study and investigate the practicality of new phenomena that occur by accident or flash of insight. Persevere with any development you believe has commercial potential."**); (ii) a ladder of abstraction [**1. Machine Sketches, page 8 / 10 ("If your machine is complicated, you should show an exploded view of it, as in Fig. 8D."**); (iii) prior art (**C. The Novelty and Unobviousness Requirement, page 1 / 4 "prior art ..."**), novelty (**C. The Novelty and Unobviousness Requirement, page 1 / 4 "...novelty requirement ..."**), nonobviousness (**C. The Novelty and Unobviousness Requirement, page 1 / 4 "...unobvious ..."**), inventive step (**B. Inventing by Problem Recognition and Solution, page 2 / 2, "Now that you know what an invention ... 1) recognizing a problem, and 2) fashioning a solution."**), and bar dates (**Experiment exception vi. Prior Sale or On-Sale Status in the U.S, page 5 / 12-5 / 13 "35 U.S.C. 102 statutory bar"**); (iv)

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inventorship A. What I mean by "Invention" page 2 / 2 *"For the purpose of this book ... useful."*; and (v) enablement and written description [G. Software and Other Computer-Related Inventions, page 8 / 7 - 8 / 8 (see page 8 / 8, left column, second paragraph, *"The special consideration applicable to software inventions is in meeting the full disclosure requirement. ... That is, make absolutely sure it contains a 'full, clear, concise, and exact' description of the invention and how to make and use it."*)];

(b) defining detail of the basic invention the defining detail of the basic invention comprises any one or more of the following: (i) interviewing an inventor to identify or otherwise characterize a basic invention [(You Don't Have to Use a Patent Attorney, page 1 / 1, *"In this view, it's almost a universal misconception that one must use a patent attorney to get a valid patent ..."*)]; and (iii) repeating (b)(i) invention [(You Don't Have to Use a Patent Attorney, page 1 / 1, *"In this view, it's almost a universal misconception that one must use a patent attorney to get a valid patent ..."*)] to (b)(ii); [(see below)]

(c) growing the basic invention by a method comprising any one or more of the following steps:

(i) identifying the basic invention; [(The Science and Magic of Inventing, page 2 / 2 *"Inventing provides things that enhance ... It could turn out to be something great!"*)] (ii) selecting a questioning theme; (iii) identifying an aspect of the basic invention that falls within the questioning theme; (iv) identifying enhancements to the basic invention by the inventor(s), wherein the enhancements relate to the aspect of the invention; (v) repeating (c)(iii) - (c)(iv) one or more times for alternate aspects of the basic invention a questioning theme; and (vi) repeating (c)(ii) - (c)(v) one or more times for alternate questioning themes;

(d) documenting and/or recording output of any of steps (b)(i)-(b)(iii) and (c)(i)-(c)(vi).

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[Chapter 3, Documentation Can Be Vital, page 3 / 1 (see B. Documents Are Vital to the Inventive Process 3/2 & C. Documentation is Vital to Prove Invention 3/3)]; and (e) documenting and/or recording administrative information. [Documentation Can Be Vital, Chapter 3, (D. Documents Are Vital to the Invention Process, page 3 / 2 "*It takes more than a good idea to sustain the invention process. It is absolutely essential to keep good, sound, records, for the following reasons: ...* ")]

Pressman does not teach,

(b)(ii) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (b)(i), however, *DeMatteis* teaches (b)(ii) facilitating conception of inventive elements using creative stimulus comprising how-type questions relating to the functioning of the invention identified in (b)(i), [(Table of Content, 2. Your Inventive Strategy, page 6 of 14, *How to get Prototypes Made at Little or No Cost to You*" & 3. Developing Your Invention, page 7 of 14, "*How to Make Your Inventions People Friendly*")]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matters pertains, to employ the questioning methodology i.e., specifically how-type questions, because when you are seeking specific information, about a process as complex, lucrative, time consuming, and expensive (i.e., for some inventors) as the inventive process, from start to completion. One of the most efficient, and comprehensive ways of obtaining the desired information is to use who, what, why, where, when, and how-type questions until they are exhausted, as a means to an end, for the purpose of knowing your audience. Discover as much as possible about your audience before you prepare

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what you are going to say, continue to learn who they are even as you step to and through the problem. When you learn as much as you can about your audience, you'll become more comfortable with them and knowledgeable about them. Rapport will be established., and (c) iterating (b)(i) to (b)(ii). [(see above)]

Regarding Claim 12:

Pressman teaches,

The method of claim 12 wherein the alternate questioning themes comprise one or more themes selected from the group consisting of:

- (a) disadvantages of the basic invention [(Inventor's Commandment #5, page 4 / 2 "*Don't spend significant time or money on your creation until you have thoroughly evaluated it for commercial potential, including considering all of its advantages and disadvantages.*")];
- (b) advantages of the basic invention [(Inventor's Commandment #5, page 4 / 2 "*Don't spend significant time or money on your creation until you have thoroughly evaluated it for commercial potential, including considering all of its advantages and disadvantages.*")];
- (c) operability issues [(E. Solving Creativity Problems, page 2 / 6 "*Unfortunately, hardly any invention ever works right ... I failed my way to success.*" ")];
- (d) other ways to solve a same problem [(D. Making Ramifications of Your Invention, page 2 / 6 "*Once you've made an invention ... Why ramify?*")];
- (e) licensing strategies [(G. Licensing of Inventions – An Overview, page 16 / 8 "*Usually, the owner of a patent application or patent needs to allow others to make or sell the patented invention ...*" ")]; and

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(f) identification of competitors and/or competitive products. [(D. Making Ramifications of Your Invention, page 2 / 6 "Once you've made an invention ... Why ramify? item (1), (2) ...")]

Conclusion

20. The prior art made of record and (listed of form PTO-892) not relied upon is considered pertinent to applicant's disclosure as follows. Applicant or applicant's representative is respectfully reminded that in process of patent prosecution i.e., amending of claims in response to a rejection of claims set forth by the Examiner per Title 35 U.S.C. The patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and any objections made. Moreover, applicant or applicant's representative must clearly show how the amendments avoid or overcome such references and objections. See 37 CFR § 1.111(c).

Correspondence Information

21. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes who may be reached via telephone at (703) 308-6280. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding After Final issues, please send it to (703) 746-7238. If you need to send an Official facsimile transmission, please send it to (703) 746-7239. If you would like to send a Non-Official (draft) facsimile transmission the fax is (703) 746-7240. If attempts to reach the examiner by tele-

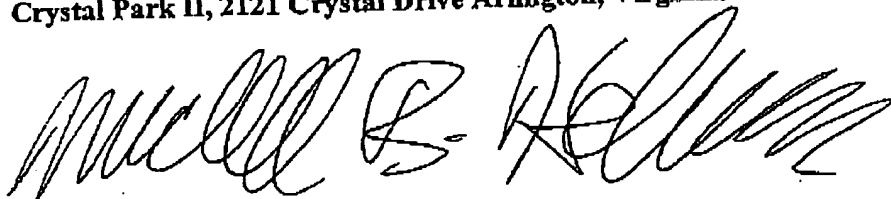
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phone are unsuccessful, the Examiner's Supervisor, Anil Khatri, may be reached at (703) 305-0282.

Any response to this office action should be mailed to:

Director of Patents and Trademarks Washington, D.C. 20231. Hand-delivered responses should be delivered to the Receptionist, located on the fourth floor of Crystal Park II, 2121 Crystal Drive Arlington, Virginia.



Michael B. Holmes

Patent Examiner

Artificial Intelligence

Art Unit 2121

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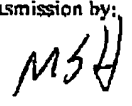
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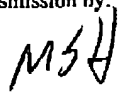
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John E. Cronin

Serial No.: 09/781,361

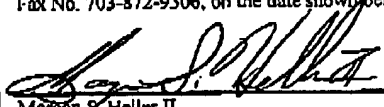
Filed: February 12, 2001

Title: Invention Interview Process

Attorney Docket No.: ipCG-509
(07689-00021)

Group Art Unit: 2121

Examiner: Michael B. Holmes

<input checked="" type="checkbox"/> CERTIFICATION OF FACSIMILE TRANSMISSION
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March 4, 2004

Response Transmittal

Transmitted herewith for filing is a Response to First Office Action with regard to the above-identified Application.

- ☐ No additional fee is required.
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Page 1 of 2

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CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL 17	MINUS	20	= 0	x \$18.00/ \$9.00 =	\$0.00
INDEPENDENT 4	MINUS	3	= 1	x \$86.00/ \$43.00 =	\$43.00
1ST PRESENTATION OF MULTIPLE DEP. CLAIMS				\$290.00/ \$145.00 =	\$0.00
				TOTAL	\$43.00

- ☒ Please charge Deposit Account No. 04-1588 in the amount of \$43.00. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 04-1588. A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. §1.16.
- ☒ Any patent application processing fees under 37 C.F.R. §1.17.

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC

By: 

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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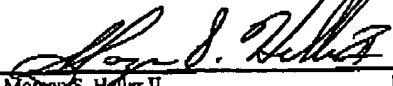
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Morgan S. Heller II Date

RESPONSE TO FIRST OFFICE ACTION

This is in response to the Office Action (paper no. 7) mailed from the U.S. Patent and Trademark Office on December 4, 2003, with respect to the above-identified patent application. Amendments to the Specification, Amendments to the Claims and Remarks concerning the Office Action appear in the sections that follow.

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AMENDMENTS TO THE SPECIFICATION

On page 1, lines 2-25, delete the entire Section 1 and replace it with the following:

--1. Related Application Data

This application claims the benefit of priority of U.S. Provisional Patent Application Serial No. 60/181,741, filed February 11, 2000, and titled "Invention Interview Process," that is incorporated by reference herein in its entirety.--

Amend the paragraph appearing on page 6, lines 11-16 as follows:

The invention generally relates to a method for interviewing one or more inventors to identify information relating to an invention, enhancing the invention through a structured interview, and documenting the output of the invention interview in a systematic way to accurately and comprehensively define the potential intellectual property space that the invention covers. The method of the invention also facilitates the creation of an invention disclosure document, provisional patent application, or utility patent application. For a further understanding of the present invention and its context, it may be desirable to review the following related U.S. patent applications, each of which is incorporated herein by reference: U.S. Application Serial No. 09/781,365, filed February 12, 2001 and entitled "Process for Facilitating the Conception of Inventions in a Directed Manner;" U.S. Application Serial No. 09/781,368, filed February 12, 2001 and entitled "Network Based System and Method for Facilitating the Conception of Inventions in a Directed Manner;" U.S. Application Serial No. 09/781,362, filed February 12, 2001 and entitled "Automated IP Tracking System and Method;" and U.S. Application Serial No. 09/766,456, filed January 19, 2001 and entitled "Scanning Invention Process."

Amend the paragraph appearing on page 10, lines 8-12 as follows:

Points 1, 2, 3, 4 and 5 are encircled in Figure 3. Point 1 represents the starting point in this aspect of the invention. Point 1 shows a brief description of marker 201, representing the concept of the invention as it has been established upon completion of the method described in

Section 6.2.1. The ink level in the dry erase marker can be viewed through a clear plastic window 307 along the side of the marker body ~~301~~305.

Amend the paragraph appearing on page 10, lines 21-26 as follows:

Similarly, the question "Why is point 2 important?" results in the observation by the inventor that the user needs to avoid running out of fluid during a presentation. This observation points to a problem: how to prevent ink from running out. The identification of the problem leads to a solution: a secondary ink fluid reserve tank that allows a fixed short amount of writing time and shown as point 3 uses a penetrable ink bladder ~~313~~314 activated by pressing a button ~~314~~315 on the dry erase marker body.

Amend the paragraph appearing on page 11, lines 17-23 as follows:

Referring again to Figure 3, asking the question "How is point 1 achieved?" elicits point 4, which is a more detailed explanation of the original invention 301. Point 4 solves a new problem of how to create a window in a plastic cylinder. Point 4 provides a potentially patentable plastic mold 304A/304B and/or molding process comprising an inner solid cylinder 310 and an outer hinged cylinder 311 with a metal insert ~~313~~312 arranged such that when plastic flows into the space between the inner and outer cylinders, an open region is formed into which a clear plastic window is inserted.

[THE REST OF THIS PAGE INTENTIONALLY LEFT BLANK]

AMENDMENTS TO THE CLAIMS

Please amend the claims as follows:

1. (Canceled)
2. (Currently amended) The method of claim + 13 wherein ~~the~~ said basic invention is identified and/or characterized by accomplishing any one or more of the following steps:
 - (a) facilitating drawing of a diagram of ~~the~~ said basic invention;
 - (b) facilitating definition of one or more elements of ~~the~~ said basic invention; and
 - (c) facilitating definition of problem(s) solved and/or problems to be solved by ~~the~~ said basic invention.
3. (Currently amended) The method of claim + 13 further comprising the step of communicating to ~~the inventors~~ said at least one inventor any one or more concepts selected from the group consisting of:
 - (a) ~~concept of an~~ said basic invention being a function of the problem to be solved by ~~the~~ said basic invention, the element(s) that comprise the basic invention, and how the elements are connected or interrelated;
 - (b) ~~a ladder of abstraction;~~
 - (c) ~~prior art, novelty, nonobviousness, inventive step, and bar dates;~~
 - (d) (c) inventorship; and
 - (e) (d) enablement and written description.
4. (Canceled)
5. (Currently amended) The method of claim 1 further comprising the step of documenting and/or recording administrative information.
6. (Canceled)

7. **(Currently amended)** The method of claim 7 16 wherein ~~the alternate questioning themes comprises one or more themes~~ said at least one second questioning theme is selected from the group consisting of:
- (a) disadvantages of the said basic invention;
 - (b) advantages of the said basic invention;
 - (c) operability issue(s);
 - (d) other ways to solve a same problem;
 - (e) licensing strategies; and
 - (f) identification of competitors and/or competitive products.
8. **(Currently amended)** The method of claim 7 16 further comprising prior to the ~~"growing" of the basic invention step (b), the step of communicating to the inventor(s)~~ said at least one inventor any one or more concepts selected from the group consisting of:
- (a) ~~concept of an~~ said basic invention being a function of the problem to be solved by the said basic invention, the element(s) that comprise ~~the~~ said basic invention, and how the element(s) are connected or interrelated;
 - (b) ~~a ladder of abstraction;~~
 - (e) ~~prior art, novelty, nonobviousness, inventive step, and bar dates;~~
 - (d) (c) inventorship; and
 - (e) (d) enablement and written description.
9. **(Canceled)**
10. **(Currently amended)** The method of claim 7 16 further comprising the step of documenting and/or recording administrative information.
11. **(Canceled)**
12. **(Currently amended)** The method of claim ~~13~~ 19 wherein ~~the alternate questioning themes comprise one or more themes~~ said at least one second questioning theme is selected from the group consisting of:
- (a) disadvantages of the said basic invention;

- (b) advantages of the said basic invention;
- (c) operability issue(s);
- (d) other ways to solve a same problem;
- (e) licensing strategies; and
- (f) identification of competitors and/or competitive products.

13. (New) A method of producing an invention document, comprising the steps of:

- (a) communicating to at least one inventor the concept of ladder of abstraction;
- (b) interviewing said at least one inventor to identify or otherwise characterize a basic invention;
- (c) questioning said at least one inventor with how-type questions relating to the functioning of said basic invention, said how-type questions structured so as to elicit at least one response from said at least one inventor directed to enabling at least one detail of said basic invention;
- (d) iterating steps (b) and (c) at least once; and
- (e) recording in an invention document subject matter of at least some of said responses elicited from said inventor in steps (b)-(d).

14. (New) The method of claim 4 wherein said invention document is an invention disclosure form.

15. (New) The method of claim 4 wherein said invention document is an application to a governmental patent office.

16. (New) A method of producing an invention document, comprising the steps of:

- (a) communicating to at least one inventor the concept of ladder of abstraction;
- (b) identifying a basic invention having a plurality of aspects;
- (c) selecting a first questioning theme selected to elicit from said at least one inventor at least one enhancement of at least one of said plurality of aspects of said basic invention;

- (d) eliciting from said at least one inventor at least one of said plurality of aspects of said basic invention that relates to said first questioning theme;
- (e) eliciting from said at least one inventor via said first questioning theme said at least one enhancement;
- (f) repeating steps (c)-(e) at least one time for alternate ones of said plurality of aspects within said first questioning theme;
- (g) repeating steps (c)-(e) at least one time for at least one second questioning theme; and
- (h) recording in an invention document subject matter of at least some of said responses elicited from said inventor in steps (b)-(d).

17. (New) The method of claim 9 wherein said invention document is an invention disclosure form.
18. (New) The method of claim 9 wherein said invention document is an application to a governmental patent office.
19. (New) A method of producing an invention document, comprising the steps of:
- (a) communicating to at least one inventor the concept of ladder of abstraction;
 - (b) communicating to said at least one inventor at least one of the concepts selected from the group consisting of:
 - (i) a basic invention being a function of the problem to be solved by said basic invention, the element(s) that comprise said basic invention, and how the element(s) are connected or interrelated;
 - (ii) prior art, novelty, nonobviousness, inventive step, and bar dates;
 - (iii) inventorship; and
 - (iv) enablement and written description;
 - (c) defining detail of said basic invention by performing at least one of the steps of:
 - (i) interviewing said at least one inventor to identify or otherwise characterize said basic invention;
 - (ii) questioning said at least one inventor with how-type questions relating to the functioning of said basic invention, said how-type questions structured so as to

- elicit at least one response from said at least one inventor directed to enabling at least one detail of said basic invention; and
- (iii) iterating steps (b)(i) and (b)(ii) at least once;
- (d) growing said basic invention, wherein said basic invention has a plurality of aspects, by performing at least one of the steps of:
- (i) selecting a first questioning theme selected to elicit from at least one inventor at least one enhancement to at least one of said plurality of aspects of said basic invention;
- (ii) eliciting from said at least one inventor at least one of said plurality of aspects of said basic invention that relates to said first questioning theme;
- (iii) eliciting from said at least one inventor via said first questioning theme said at least one enhancement;
- (iv) repeating steps (c)(ii)-(c)(iii) at least one time for alternate ones of said plurality of aspects within said first questioning theme; and
- (v) repeating steps (c)(i)-(c)(iv) at least one time for at least one second questioning theme; and
- (e) including in an invention document subject matter of at least some of said responses elicited from said at least one inventor in steps (b)(ii) and (b)(iii) and at least some of said enhancements elicited from said at least one inventor in steps (c)(iii)-(c)(v).
20. (New) The method of claim 19 wherein said invention document is an invention disclosure form.
21. (New) The method of claim 19 wherein said invention document is an application to a governmental patent office.
22. (New) An article comprising a computer readable medium containing a computer program for executing a method of producing an invention document, the method comprising the steps of:
- (a) communicating to at least one inventor the concept of ladder of abstraction;

- (b) interviewing said at least one inventor to identify or otherwise characterize a basic invention;
- (c) questioning said at least one inventor with how-type questions relating to the functioning of said basic invention, said how-type questions structured so as to elicit at least one response from said at least one inventor directed to enabling at least one detail of said basic invention; and
- (d) iterating steps (b) and (c) at least once.

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REMARKS

Claims 2, 3, 5, 7, 8, 10 and 12-22 are presently pending. Claim 1, 4, 6, 9 and 11 have been canceled. Claims 2, 3, 5, 7, 8, 10 and 12 have been amended. Claims 13-22 have been added. The specification has been amended.

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the remarks appearing below.

Draftsperson's Objections to the Drawings

The draftsperson objected to the drawings filed on February 12, 2001 stating that the margins of FIGS. 1 and 3 are unacceptable. Applicants have revised the drawings accordingly. Corrected drawings are attached hereto, and have also been submitted to the draftsperson directly. In addition, Applicant has corrected two minor errors in the drawings, namely, changing element numeral "301" in FIG. 3 to "201" to correspond to the written description and changing the lead line corresponding to element numeral "310" for the same reason.

Objections to the Claims

The Examiner has objected to claims 1, 7 and 12 due to the following informalities. Claim 1 refers to an iteration step (c) wherein steps (b)(i) and (b)(ii) are repeated. However, claim 1 does not include steps (b)(i) and (b)(ii). Claim 7 is dependent upon itself. Claim 12 is dependent from a nonexistent claim.

Applicant has amended claims 1, 7 and 12 to overcome these informalities. Regarding claim 1, Applicant has amended this claim to recite that the iteration step refers to steps (a) and (b), which are present in claim 1. Regarding claim 7, Applicant has amended this claim to depend from new claim 16. Regarding claim 12, Applicant has amended this claim to depend from new claim 19.

Consequently, Applicant respectfully requests that the Examiner withdraw the objections.

Rejection under 35 U.S.C. § 101

The Examiner has rejected claims 1-12 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. In particular, the Examiner asserts that claims 1-12 are directed to

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an abstract idea not limited to a practical application in the technological arts. Applicant respectfully disagrees.

Claims 2, 3, 5, 7, 8, 10 and 12-21, as amended and added, are directed to a method of producing an invention document by performing at least the steps recited in the various claims. The result of performing the method of these claims, i.e., an invention document containing information relating to a basic invention, is a "useful, concrete and tangible result." AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1368, 1358-59 (Fed. Cir. 1998). State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998) ("Today, we hold that the transformation of data . . . constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result'—a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.""). Consequently, the claims at issue meet the requirement for statutory subject matter that the Federal Circuit laid out in State Street and further reinforced in AT&T.

Some, including the U.S. Patent and Trademark Office (USPTO), have asserted that despite the holdings of the Federal Circuit in State Street and AT&T, there is still life to the requirement of pre-State Street/AT&T law that statutory subject matter be in the "technological arts," meaning that the subject matter must fall within the context of scientific technology. For example, relative to a process that could be performed by a human or a computer, the process must be claimed in the context of a computer in order to meet the "in the technological arts" requirement for statutory subject matter. While Applicant does not doubt that statutory subject matter must be within the "technological," i.e., "useful," arts, Applicant disputes that the definition of "technological arts" requires a process to be performed by a computer to be statutory, even though when performed by a human the process produces a useful, concrete and tangible result in the manner of State Street and AT&T.

To the best of Applicant's knowledge, the only post-State Street/AT&T decision cited in support of this definition of the term "technological art" is Ex parte Bowman, 61 USPQ2d (BNA) 1669 (Bd. Pat. App. & Int. 2001). Generally, in Ex parte Bowman the Board of Patent Appeals and Interferences (BPAI) held that a claim that could be performed by either a human or

a computer, but did not recite any limitations directed to computer implementation, is not subject matter falling within the "technological arts" and thus is not statutory. Id., at 1671. This holding appears to be at odds with the law of State Street and AT&T. For example, in AT&T the Federal Circuit found that a claim to process that did not include any limitations directed to a computer were indeed statutory. AT&T, at 1361.

Applicant submits that there are at least two serious problems with relying on Ex parte Bowman to support a position that appears to be in opposition to the Federal Circuit's holdings in State Street and AT&T. First, Ex parte Bowman applied pre-State Street/AT&T law long after the Federal Circuit decided State Street and AT&T without discussing, let alone mentioning whatsoever, the State Street and AT&T decisions. Since there appears to be a large amount of tension between pre- State Street/AT&T law on the meaning of "useful" or "technological" art and the State Street and AT&T decisions, the BPAI should have addressed these two cases in its decision. Second, the BPAI indicated that its Ex parte Bowman decision was not written for publication. Therefore, the Ex parte Bowman decision is not binding precedent on which the USPTO should rely. Rather, the USPTO should rely on Federal Circuit law such as State Street and AT&T.

As discussed above, an analysis of the claims at issue under present Federal Circuit law, e.g., State Street and AT&T, shows that these claims indeed fall within 35 U.S.C. § 101. Consequently, Applicant respectfully asserts that claims 2, 3, 5, 7, 8, 10 and 12-22, as added and amended, are directed to statutory subject matter and, therefore, requests that the Examiner withdraw the present rejection.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, as failing to enable someone having ordinary skill in the art to use the invention. In particular, the Examiner states that because the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law under 35 U.S.C. § 112, first paragraph, to enable someone skilled in the art to use the invention. Applicant respectfully disagrees.

For the reasons discussed above relative to the rejection under 35 U.S.C. § 101, Applicant believes that the claims as a matter of fact are directed to statutory subject matter and, therefore,

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satisfy 35 U.S.C. § 101. Consequently, Applicant asserts that the application does not fail as a matter of law under 35 U.S.C. § 112, first paragraph, to enable someone skilled in the art to use the invention. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection. If the Examiner again rejects any of the claims under 35 U.S.C. § 112, first paragraph, Applicant reserves the right to further argue the rejection.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claims 6-10 under 35 U.S.C. § 102(b) as being anticipated by PATENT IT YOURSELF (6th ed., 1997) (Nolo Press Berkeley) by David Pressman, stating that Pressman discloses all of the limitations of these claims. Applicant respectfully disagrees.

The book, PATENT IT YOURSELF, is generally a how-to guide for inventors having little or no experience with the processes of inventing, seeking legal protection for an invention and marketing an invention. In this book, Pressman provides information in a variety of formats, including instructions, examples, lists and descriptions, among others, for increasing the knowledge of inventors regarding the processes noted above. In Chapter 2, Section B, "Inventing by Problem Recognition and Solution," Pressman discloses that inventing is generally a two-step process: "1) recognizing a problem, and 2) fashioning a solution" to the problem. Pressman goes on to present a number of specific inventions and addresses for each one the problem recognized and the solution to the problem.

In contrast, the present invention is directed to, among other things, a method of producing an invention document, e.g., an invention disclosure or a patent application, among others, utilizing a structured system of asking an inventor, or inventors, one or more types of questions particularly formulated to elicit one or more corresponding types of responses from the inventor(s). After the inventor(s) respond, at least some of the subject matter of the response(s) is included in the invention document. This structured system has a number of benefits, including the creation of an invention document that enables an invention and describes enhancements of a basic invention.

Regarding new independent claim 16, which generally replaces original claim 6, claim 16, requires, among other things, the steps of: 1) selecting a first questioning theme selected to elicit from at least one inventor at least one enhancement of at least one of a plurality

of aspects of a basic invention; 2) eliciting from the at least one inventor at least one of the aspects of the basic invention that relates to said first questioning theme and 3) eliciting from the inventor via the first questioning theme the at least one enhancement. Pressman does not disclose these steps. Pressman, at most, can be said to disclose that an inventor asks the questions, "what is the problem?" and "what is a solution to the problem?" However, neither of these questions can be fairly said to be directed to at least one aspect of a plurality of identified aspects that has been elicited from at least one inventor, as required by claim 16. Nor can it be fairly said that either of these questions particularly addresses an enhancement relating to the particular identified aspect.

In addition, new claim 16 also requires the step of communicating to the at least one inventor the concept of a ladder of abstraction. Neither Pressman nor any other reference of record discloses or suggests this step.

In view of the foregoing, Applicant asserts that Pressman fails to disclose or fairly suggest a number of limitations of new claim 16. Consequently, PATENT IT YOURSELF cannot anticipate new claim 16, nor claims 7-10, 17 and 18 that depend therefrom. Therefore, Applicant respectfully requests that the Examiner withdraw the present anticipation rejection.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-5, 11 and 12 under 35 U.S.C. § 103 as being obvious in view of the Pressman book, discussed above, and FROM PATENT TO PROFIT: SECRETS & STRATEGIES FOR THE SUCCESSFUL INVENTOR, Avery (1998) by Bob DeMatteis, stating Pressman discloses a method containing all of the limitations of these claims except facilitating conception of inventive elements using creative stimulus comprising how-type questions. The Examiner then asserts that DeMatteis discloses this limitation and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the teachings of DeMatteis in the Pressman method. Applicant respectfully disagrees.

The Pressman disclosure is as discussed above relative to the anticipation rejection.

DeMatteis, like Pressman, generally discloses how-to guidance for inventors having little or no experience with the processes of inventing, seeking legal protection for an invention and marketing an invention.

Regarding new independent claim 13, which generally replaces original claim 1, claim 13 requires, among other things, the step of questioning at least one inventor with how-type questions structured to elicit at least one response from the at least one inventor directed to enabling at least one detail of a basic invention. Neither DeMatteis nor Pressman disclose or suggest this step.

The Examiner asserts that certain phrases appearing in the table of contents of DeMatteis' book are questions corresponding to the specific how-type questions of new claim 13. Applicant believes the Examiner's assertion is improper. DeMatteis' table of contents includes the phrases "How to Get Prototypes Made at Little or No Cost to You" and "How to Make Your Invention 'People Friendly.'" First, these phrases are not questions. They are titles of sections that provide guidance to a reader on the subjects of getting a prototype made and making an invention "people friendly." Second, even if these phrases were questions, which they are not, neither of them can be fairly said to be directed to eliciting at least one response from an inventor directed to enabling at least one detail of a basic invention.

In addition, new claim 13 also requires the step of communicating to the at least one inventor the concept of a ladder of abstraction. Neither Pressman, DeMattais nor any other reference of record discloses or suggests this step.

Furthermore, Applicant asserts that the Examiner has made the present rejection in hindsight of the claims. Use of hindsight in this manner is not proper.

For at least these reasons, Applicant respectfully submits that the obviousness rejection of new claim 13, and claims 2, 3, 5, 14 and 15 that depend therefrom, is improper.

Regarding new claim 19, which generally replaces original claim 11, claim 19 requires, among other things, steps included in new claim 13, discussed immediately above, as well as steps included in new claim 16, discussed above in connection with the anticipation rejection. Since new claims 13 and 16 are allowable over the cited references for the reasons discussed

above, new claim 19 is allowable for at least the reason that it includes the subject matter of allowable claims 13 and 16.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw all of the rejections made under 35 U.S.C. § 103.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 2, 3, 5, 7, 8, 10 and 12-22, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,
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Attorneys for Applicant

BTV.261429.2

EXHIBIT D



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To: Mike Holmes From: Ryan Simmons (ipCapital Group)
Fax: 703-746-5423 Pages: _____
Phone: _____ Date: 9/22/04
Re: 09/781,361 CC: _____

☒ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply

• Comments:

Mike,

Here is the response to office action
sent on 3/4/04 in response to the
office action sent on 12/04/03.

Ryan Simmons
802-872-3200 x271

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